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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/856,362

05/22/2001

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Q64544

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EXAMINER

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ART UNIT

PAPER NUMBER

2613

MAIL DATE

DELIVERY MODE

04/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/856,362
Filing Date: May 22, 2001
Appellant(s): HAMOIR, DOMINIQUE

David J. Cushing
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the Reply Brief filed 4-9-07 and the letter of 6-20-07 and the claim appendix filed 3-3-08 appealing from the Office action mailed 1-11-06.

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Responsive to the Reply Brief filed under 37 CFR 41.41 filed on April 9, 2007, a supplemental Examiner's Answer is set forth below:

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the original appeal brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the original appeal brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix filed on 3-3-08 to the brief is correct.

The statement of the status of claims contained in the appendix filed 3-3-08 to the brief is correct.

(8) Evidence Relied Upon

6985283

ISLAM ET AL

1-2006

This reference was cited in the previous Examiner's Answer in response to a comment in the Appeal Brief that no one has considered the problems that he has (see page 14, second full paragraph of the appellant's original appeal brief "No one else, including the cited art, has explained the problem or proposed solution."). The above patent issued after the examiner had written the final office action, which is why it was not included earlier. See column 9, lines 29-38 of Islam et al. Also see column 20, lines 19-24 and 46-47.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The ground of rejection are in the original Examiner's Answer.

(10) Response to Argument

The following arguments are in response to the Reply Brief of 3-3-07.

With regard to the first argument in the Reply Brief which has the heading "Improper citation of New Art in Examiner's Answer" which is in regard to the section (8) of the Examiners Answer entitled "Evidence Relied Upon", the Appellant should see

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MPEP 1207.03, section III, "if the rejection under the basic thrust of the rejection remains the same" when new art is cited, then there is no new grounds of rejection.

The appellant argues that the examiner cited this piece of art because of a flaw in the examiner's rejection. This is not the case. The rejections in the Examiner's Answer are the same as in the previous final rejection. They have not changed in any way. The reference is used in response to the Appellants' arguments that no one has thought of doing this previously (see page 14, second full paragraph of the appellant's original appeal brief "No one else, including the cited art, has explained the problem or proposed solution."). The above patent issued after the examiner had written the final office action. See column 9, lines 29-38 of Islam et al. Also see column 20, lines 19-24 and 46-47.

With regard to the second argument in the Reply Brief which has the heading; "In re Hyatt is Inapplicable in the Present Case", the appellant argues that In re Hyatt is inapplicable since the present case is not in the form of "means plus function". (The claims do appear to be in a means plus function form. See end of this paragraph). All issues are CLEARLY discussed in Examiner's Answer page 5, second paragraph-page 7, end of second paragraph. The appellant has not responded to the many comments in the Examiner's Answer which specify why "single means" is not drawn ONLY to "means plus function" situations. For example, the MPEP section that deals with "single means" makes it clear that the "single means" issue is not only drawn to "means plus function" situations (see quotes below with regard to MPEP 2164.08(a)). The appellant never responded to the quotes from Hyatt which make it clear that the issue is with a

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"single element". Or a question that has been asked in several office actions and the Examiner's Answer, "if the fiber is causing the problem and correcting the problem, is there really a problem?". Further, it appears that the claim is in the "means plus function" form. (i. e. "a fiber (*means*) for carrying signals (*function*)... the fiber (*same means*) further provides linear losses (*function*)").

In the next paragraph of this section, it appears that the appellant is arguing that without the "single means" situation, the examiner has "not identified a single thing in claim 24 that the artisan would be unable to do". According to MPEP 2164.08(a), single means is a 35 USC 112, first paragraph problem. The examiner has asked (more than once), if a fiber causes the problem and solves the problem, is there really a problem? This has never been answered. Further, the examiner has specified that with regard to claim 25, the appellant has never taught how the attenuation is done in a distributed way. As written, the claims claim that the fiber alone is providing the compensation. The appellant argues that the fiber provides the compensation if the very broad band is positioned correctly relative to the region of the increased linear losses in the fiber (page 10, lines 1-4 of appeal brief). It appears that the appellant is arguing something essential for the invention to work, that is not claimed (the very broad band must be positioned correctly relative to the region of the increased linear losses in the fiber).

With regard to the third argument in the Reply Brief which has the heading; "Selah Does Not Teach the Claimed Invention".. All issues are discussed in the Examiner's Answer. The appellant should also see MPEP 2114, specifically the section

which says that APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART. Saleh teaches the same means in the same type of system as the Appellant (see chart on page 8 in Examiner's Answer). The Appellant argues Saleh does not teach how to set the elements so that they will operate as claimed. The Appellants' specification never teaches that the elements have to be set to operate ... so he clearly never teaches HOW to set the elements either (see last two lines of page 9-end of paragraph on page 10 of the Examiner's Answer which clearly addresses all of the arguments in this section of the Reply Brief). The appellant states that he does teach how to provide the compensations. He points to figures 1 and 2. These figures, and the specification never teach HOW this compensation is provided. The specification only teaches what type of amplifier is used in each band, which are the same types of amplifiers taught by Saleh. The appellant never teaches how to control the amplifiers to provide the functional language. See MPEP 2114.

With regard to the fourth argument in the Reply Brief which has the heading "The Examiner is Ignoring the Limitations of Claims 5, 14 and 18", once again the appellant argues that Saleh does not teach how to control the amplifiers in order to provide the functional language of the claims. The appellant never teaches how to control the amplifiers in order to provide the functional language.

All arguments with regard to the Appeal Brief have been answered in the previous Examiner's Answer.

(11) Related Proceeding(s) Appendix

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this Examiner's Answer.

Appellant may file another Reply Brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental Examiner's Answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

A Technology Center Director or designee has approved this supplemental Examiner's Answer by signing below:

Valencia Mark Weller
Director, TC2600

Leslie Pascal
Primary Examiner
AU 2613